

REMARKS:

Claims 1-20 and 27-30 are pending in this application. By this amendment, claims 1, 3-4, 16, 20 and 27-28 are amended for clarity. Entry of this amendments is proper under 37 C.F.R. §1.116 because the amendments: (1) place the application in condition for allowance; (2) do not raise any new issues requiring further search and/or consideration; and/or (3) place the application in better form for appeal, should an appeal be necessary. No new issues are raised.

Claim Rejection under 35 U.S.C. §112

Claim 30 is rejected under 35 U.S.C. §112, first paragraph. The Examiner contends that there is no support for “wherein the third value is an IMSI_10_11”. Applicants replaced “IMSI_10_11” with “IMSI_11_12” which is supported throughout the specification (see, FIGS. 2, 3A, 3B, 6 and 7). Therefore, the § 112 rejection is moot.

Claims 1-15, 27 and 30 are rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Particularly, claim 1 is rejected because it recites “the MNC has a variable length” and “the length of the MNC is greater than a fixed length”. Applicants amended claim 1 to recite “the MNC has a first length or a second length” to overcome the § 112 grounds of rejection.

Claim Rejection under 35 U.S.C. §102

Claims 1-20 and 27-30 are rejected under U.S.C. 102(e) as being anticipated by Cooper et al (US 2004/0236849 A1). This rejection is respectfully traversed as follows.

Claim 1 recites ‘the first field indicating whether the MNC has the first length or the second length’. However, Cooper does not disclose this feature. In the Office Action, the Examiner contends that “MCC” indicates whether the MNC is greater than a fixed length. However, “MCC” is the Mobile Country Code used for distinguishing the country where the

service is provided, and there is no evidence throughout Cooper for construing the MCC as an identifier for identifying the length of the MNC.

Further, in the Office Action, the Examiner contends that paragraph [0037] of Cooper discloses that if the network operator code (NOC; equivalent to MNC) is a 2-digit code, it is carried in the IMSI_11_12 and if the NOC is a 3-digit code, it is carried in the IMSI_11_12 and in the least significant bit of the MCC as presented by 'nnA'. However, lines 8-14 of paragraph [0037] of Cooper provide that "the two most significant digits of the 3-digit NOC value are carried in the IMSI_11_12 field. The 3-digit NOC may be represented as nnA, where A is a fixed 1 digit value (e.g. A=0) for the least significant digit of the MCC and nn is a 2-digit value ranging from 0 through 99 for the two most significant digits of the MCC". That is, paragraph [0037] of Cooper emphasizes that only two most significant digits of the 3-digit NOC value are carried to the receiving end (e.g., mobile station), and that the least significant digit of the NOC (which is for the least significant digit of the MCC) is a fixed digit value.

As such, Cooper teaches that if the NOC is defined as a 3-digit code, then NOC value may be assigned to the network operators in a manner to account for the broadcast of only two of the digits via the IMSI_11_12 (with a fixed value for the A digit). See paragraph [0038] of Cooper. Accordingly, only 2 most significant digit of the 3-digit NOC (which correspond to MNC of the claim 1) are transmitted with the least significant digit of the 3-digit NOC fixed between the transmission end and the receiving end. Thus, Cooper does not need the identifier for identifying whether the MNC has a first length (e.g., 2-digits) or a second length (e.g., 3-digits), because always 2 digits of the 3-digit MNC are transmitted.

Further, independent claim 1 recites that 'the first field of the message indicates whether the MNC has the first length or the second length'. And, as stated above, neither MCC nor NOC of Cooper, which are exemplary fields of the message, indicate that the MNC (or NOC) has a first length or a second length, as claimed.

For at least these reasons, Cooper does not teach or suggest all the features of independent claim 1. Thus, independent claim 1 is distinguishable over Cooper and in condition for allowance.

Independent claims 16 and 28 recite “a second value which indicates whether the length of the MNC is the first length or a second length which is greater than the first length” and “determining whether a length of the MNC is a first length which is greater than a second length based on a value of an indicator field included in a message transmitted from the mobile station”, respectively. As stated above, Cooper does not teach the indicator which indicates whether the length of the MNC is the first length or the second length.

For at least these reasons, Cooper does not teach or suggest all the claimed features of independent claims 16 and 28. Thus, independent claims 16 and 28 should be also in condition for allowance.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (emphasis added).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant’s disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a *prima facie* case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and

statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicants' claimed invention cannot establish a *prima facie* case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicants invite the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of the claims 1-20 and 27-30 are earnestly solicited.

Respectfully submitted,
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